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In re Application of:	:	
SOMMERMEYER, Klaus	:	DECISION
U.S. Application No.: 10/542,944	:	
PCT No.: PCT/EP2004/000488	:	
International Filing Date: 22 January 2004	:	
Priority Date: 23 January 2003	:	
Atty Docket No.: 3675.1002-000	:	
For: CARBONIC ACID DIESTERS,	:	
METHODS FOR THE PRODUCTION	:	
THEREOF ... WITH POLY-	:	
SACCHARIDE OR POLY-	:	
SACCHARIDE DERIVATIVES	:	

This decision is issued in response to the "Petition Under 37 CFR 1.182 To Correct The Date Of Completion Of The 35 U.S.C. 371 Requirements" filed 03 March 2009, treated herein under 37 CFR 1.181. No petition fee is required.¹

BACKGROUND

On 22 January 2004, applicant filed international application PCT/EP2004/000488. The international application claimed a priority date of 23 January 2003, and it designated the United States. On 05 August 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 23 July 2005.

On 20 July 2005, applicant filed a Transmittal Letter requesting entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee and a purported translation into English of the international application.

On 27 September 2005, applicant filed an executed German language declaration (with purported English translation).

On 03 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) identifying the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" as 20 July 2005.

¹ Applicant included a \$400 petition fee with the present petition. This unnecessary petition fee will be refunded to Deposit Account No. 08-0380.

On 22 April 2008, an Office Action was mailed herein containing a restriction requirement.

On 24 July 2008, applicant filed a response to the Office Action that included a substitute specification. Among the changes incorporated in the substitute specification was the replacement of “carboxylic acid” with “carbonic acid” throughout the specification and claims. Applicant’s response indicates that the term “carbonic acid” was improperly translated as “carboxylic acid” in the English translation of the application filed herein.

On 06 October 2008, a non-final Office Action was mailed rejecting the claims. The Office Action also objected to applicant’s amendment as introducing new matter into the application regarding “carbonic acid diesters.”

On 03 March 2009, applicant filed the Petition Under 37 CFR 1.182 To Correct The Date Of Completion Of The 35 U.S.C. 371 Requirements” considered herein. The petition indicates that the original English translation of the international application filed 20 July 2005 was defective based on the improper translation of the German term for carbonic acid. The petition requests that the defective English translation be replaced with a corrected English translation included with the present petition, that a revised Notification Of Acceptance be issued, and that the application then be examined based on the revised English translation.

DISCUSSION

A. English Translation of the International Application

Pursuant to 35 U.S.C. 371(c)(2), a national stage application filed under 35 U.S.C. 371 must include an English translation of the international application as filed. Applicant’s original national stage submission purportedly included such an English translation; however, as indicated in the present petition, the translation was defective in that the German term for “carbonic” acid was mistranslated as “carboxylic” acid throughout the translation. Because applicant had not filed a proper English translation of the international application as filed, the “Notification Of Acceptance” (Form PCT/DO/EO/903) mailed 03 February 2006, which indicated that applicant had satisfied the requirements of 35 U.S.C. 371(c)(2), was issued in error and is appropriately vacated.

It is noted that the present petition indicates that it was accompanied by a copy of a corrected English translation of the international application. However, the purported English translation provided with the petition is not acceptable. Specifically, the English translation fails to correspond to the international application as filed. For example, the translation includes the “Related Applications” paragraph that was added by amendment when the application entered the national stage and is not present in the international application as filed. In addition, the translation also includes section headings which are not present in the published international application. Thus, applicant has still failed to submit an acceptable English translation of the international application as filed. A “Notification of Missing Requirements” (Form PCT/DO/EO/905) will be issued requiring submission of an acceptable English translation of the

international application as filed and the \$130 processing fee for filing the translation later than thirty months after the priority date.

B. The Declaration

The present application file includes two declaration documents. One is a copy of a declaration filed during the international phase pursuant to PCT Rule 4.17(iv). The declaration was not included with the international application as filed (it was executed on 02 February 2004, after the international filing date). A declaration under PCT Rule 4.17(iv) may be filed after the international filing date (see PCT Rule 26ter); however, as stated on the face of the declaration form and in the instructions thereto, any declaration filed after the international filing date must set forth the international application number. The declaration filed by applicant here did not set forth the international application number. Accordingly, the declaration is not acceptable as filed and cannot be accepted in satisfaction of the declaration requirements set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.497.

The second declaration present in the application file is the German language declaration filed 27 September 2005. This declaration includes a purported English translation of the German portion of the declaration; however, the form used by applicants is not a form provided by the USPTO. Accordingly, pursuant to 37 CFR 1.68(b), applicant was required to provide an English translation together with a statement that the translation is accurate. No statement confirming the accuracy of the English translation of this declaration was filed by applicant here. Moreover, it is evident that the English translation of the title contained on the declaration is inaccurate, because it includes the term "carboxylic acid," which applicant confirms in the present petition is not an accurate translation of the original German. Based on the failure of applicant to provide a correct English translation of the declaration filed 27 September 2005, such declaration is not acceptable as filed.

In view of the above, applicant has not submitted herein an acceptable declaration in compliance with 37 CFR 1.497. Accordingly, a "Notification of Missing Requirements" (Form PCT/DO/EO/905) will be issued requiring submission of an acceptable oath or declaration in compliance with 37 CFR 1.497 and the \$65 small entity surcharge for filing the oath or declaration later than thirty months after the priority date.

C. Office Actions Mailed 22 April 2008 and 06 October 2008

As discussed above, applicant has not yet satisfied the English translation requirement of 35 U.S.C. 371(c)(2) or the oath or declaration requirement of 35 U.S.C. 371(c)(4). The mailing of an Office action based on an examination of the application is not appropriate prior to applicant's successful completion of the requirements set forth in 35 U.S.C. 371(c). Moreover, the Office Actions issued herein were based on an incorrect English translation of the international application. Under these circumstances, the Office Actions mailed on 22 April 2008 and 06 October 2008 are appropriately vacated as having been issued prematurely and on the basis of an incorrect translation.

CONCLUSION

The petition to correct the 35 U.S.C. 371(c) date is **GRANTED** to the extent that the "Notification Of Acceptance" (Form PCT/DO/EO/903) mailed on 03 February 2006 is hereby **VACATED**.

As discussed above, applicant has not yet satisfied the English translation requirement of 35 U.S.C. 371(c)(2) or the oath or declaration requirement of 35 U.S.C. 371(c)(4).

In addition, because applicant has not yet satisfied the requirements of 35 U.S.C. 371(c), the mailing of Office Actions on 22 April 2008 and 06 October 2008 was premature (and based on an incorrect English translation of the international application). These Office Actions are therefore hereby **VACATED**.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing, including the mailing of a Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an acceptable English translation of the international application as filed, the \$130 processing fee for filing the translation later than thirty months after the priority date, an acceptable oath or declaration in compliance with 37 CFR 1.497, and the \$65 small entity surcharge for filing the oath or declaration later than thirty months after the priority date.



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